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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,970	10/14/2003	Dale W. Malik	190250-1340	7957
38823	7590	10/17/2007	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ AT&T BLS Intellectual Property, Inc. 600 GALLERIA PARKWAY SUITE 1500 ATLANTA, GA 30339			CHANG, JUNGWON	
		ART UNIT	PAPER NUMBER	
		2154		
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		10/17/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/685,970	MALIK, DALE W.
	Examiner	Art Unit
	Jungwon Chang	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date 10/14/03
- 4) Interview Summary (PTO-413)

Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. Claims 1-16 are presented for examination.
2. The specification is objected to because the following informalities:

The cross-reference to related applications cited in page 1 of the specification have to be updated to include US Patent numbers.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

On page 48, lines 1-15 of the present specification, which states in part:

context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific examples (a non exhaustive list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (electronic), a read-only memory (ROM) (electronic), an erasable programmable read-only memory (EPROM or Flash memory) (electronic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM) (optical). Note that the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be

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electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory.

Functional Descriptive material in combination with an appropriate computer readable medium must be capable of producing a useful, concrete and tangible result when used in a computer system.

- Cf. *In re Warmerdam* – data structure stored in a computer memory, and *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994) – data structure in a “computer readable medium”.
- The “computer readable medium” must be physical structure, not a signal, which permits the functionality to be realized with the computer.

The computer readable medium must be **physical structure which provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality** (e.g., a transmitter or a receiver), and a piece of paper with the functional descriptive material written on it are all examples of media which are not believed to enable the functionality to be realized with the computer.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Couts et al. (US 2003/0120805), hereinafter Couts.
7. As to claim 1, Couts discloses a first communication device comprising:
means for receiving an instant messaging (IM) message (204, fig. 2); and
means for conveying the IM message to a second communication device (228, fig. 2,
"message forwarded to the available next user or device").
8. As to claim 2, Couts discloses a first communication device comprising:
receive logic configured to receive an instant messaging (IM) message (204, fig.
2); and
convey logic configured to convey the IM message to a second communication
device (228, fig. 2, "message forwarded to the available next user or device").
9. As to claim 3, Couts discloses wherein the convey logic is further configured to
automatically convey the IM message to the second communication device (page 1,
0001, "automatically forwarding").
10. As to claim 4, Couts discloses a communication method comprising the steps of:
receiving an instant messaging (IM) message at a first communication device,

the IM message being intended for a recipient (204, fig. 2); and
conveying the IM message to a second communication device (228, fig. 2,
“message forwarded to the available next user or device”).

11. As to claim 5, Couts discloses further comprising the step of: determining presence of the intended recipient at the second communication device prior to conveying the IM message to the second communication device (226, fig. 2, “next device available”).

12. As to claim 11, it is rejected for the same reasons set forth in claim 1 above. In addition, Couts discloses a computer-readable medium comprising: computer-readable code adapted to instruct a programmable device (page 2, 0015, “memory for storage of applications and data; page 3, 0020, “client software stored by the client devices”).

13. As to claim 12, it is rejected for the same reasons set forth in claim 5 above.

14. Claims 6-10 and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Appelman et al. (US 6,539,421), hereinafter Appelman.

15. As to claim 6, Appelman discloses a communication method comprising the steps of:
receiving an instant messaging (IM) message intended for a recipient, the

recipient having IM addresses (col. 3, lines 4-11, "receiving addresses of instant message recipients");

determining a presence of the recipient at each of the IM addresses (506, fig. 9; col. 5, line 43 – col. 6, line 7, "entries 502 for persons who are currently online, which is determined by checking the online status fields 506"); and

conveying the received IM message to the IM addresses at which the recipient is present (col. 6, line 16 – col. 7, line 7; col. 8, lines 10-30; col. 14, lines 45-49, "potential instant message recipient is currently online").

16. As to claim 7, Appelman discloses a communication method comprising the steps of:

receiving an instant messaging (IM) message intended for a recipient, the recipient having IM addresses (col. 3, lines 4-11, "receiving addresses of instant message recipients");

determining a last active time for each of the IM addresses (508, fig. 9, "time stamp"; col. 6, line 16 – col. 6, line 7, "the most recent time in its time stamp field 506"); and

conveying the received IM message to the IM address having a most recent last active time (508, fig. 9, "time stamp"; col. 8, lines 10-30, "Barry was corresponded with more recently than Bartholomew"; col. 6, line 16 – col. 6, line 7, "the most recent time in its time stamp field 506")

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17. As to claim 8, Appelman discloses further comprising the step of: determining a presence of the recipient at each of the IM addresses prior to determining the last active time (506, fig. 9; col. 5, line 43 – col. 6, line 7, “entries 502 for persons who are currently online, which is determined by checking the online status fields 506”); and wherein the step of determining the last active time comprises the step of determining the last active time for each of the IM addresses at which the recipient is present (508, fig. 9, “time stamp”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”).

18. As to claim 9, Appelman discloses, wherein the step of conveying the received IM message comprises the step of: conveying the IM message to a most recent IM address at which the recipient is present, the most recent IM address being the IM address having the most recent last active time (508, fig. 9, “time stamp”; col. 8, lines 10-30, “Barry was corresponded with more recently than Bartholomew”; col. 6, line 16 – col. 6, line 7, “the most recent time in its time stamp field 506”).

19. As to claim 10, Appelman discloses further comprising the step of: determining a presence of the recipient at each of the IM addresses (506, fig. 9; col. 5, line 43 – col. 6, line 7, “entries 502 for persons who are currently online, which is determined by checking the online status fields 506”); and wherein the step of conveying the received IM message comprises the step of conveying the received IM message to the IM address at which the recipient is present (508, fig. 9, “time stamp”; col. 8, lines 10-30, “Barry was corresponded with more recently than Bartholomew”; col. 6, line 16 – col. 6,

line 7, "the most recent time in its time stamp field 506").

20. As to claim 13, it is rejected for the same reasons set forth in claim 6 above. In addition, Appelman discloses a computer-readable medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

21. As to claim 14, it is rejected for the same reasons set forth in claim 7 above. In addition, Appelman discloses a computer-readable medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

22. As to claim 15, it is rejected for the same reasons set forth in claim 8 above. In addition, Appelman discloses a computer-readable medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

23. As to claim 16, it is rejected for the same reasons set forth in claim 9 above. In addition, Appelman discloses a computer-readable medium comprising: computer-readable code adapted to instruct a programmable device (col. 13, lines 30-56).

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Mendiola et al, US 2002/0143916, McCarty et al, US 2002/0029269, Mendiola et al, US

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2002/0143916, Kobayashi et al, US 2007/0005809, Lee et al, US 2004/0117445

disclose a method and system for tracking the online status of active users of an internet-based instant messaging system.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is 571-272-3960. The examiner can normally be reached on 6:30-2:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 25, 2007


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